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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

ATTY DOCKET NO.: TUC920010026US1

In re Application of:

VICKIE L. BREWER, ET AL.

Examiner: Paul H. Nguyen Ba

Serial No.: 09/852,959

Art Unit: 2176

Filed: May 10, 2001

Customer No.: 46335

For: S/M FOR IMPROVING THE
PERFORMANCE OF A WEB APPLICATION BY
BUILDING ONLY REQUESTED WEB PAGES
ONLY IN A REQUESTED HUMAN LANGUAGE

Conf. No.: 5329

APPEAL BRIEF UNDER 37 C.F.R. §41.37Mail Stop Appeal Briefs - Patents
Commissioner for Patents
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Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Appeal of Examiner Paul H. Nguyen Ba's final rejection of the above-identified patent application. This Appeal was requested in the Notice of Appeal under 37 C.F.R. §41.31 submitted on September 29, 2005 and received by the U.S.P.T.O. on October 3, 2005. Please charge any necessary fees and credit any overpayments associated with the submission of this brief or otherwise necessary to further prosecution of this application to IBM Corporation Deposit Account No. 09-0449.

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11-1-2005

Date

Jane Graham

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REAL PARTY IN INTEREST

The real party in interest in the present Application is International Business Machines Corporation, the Assignee of the present application as evidenced by the Assignment set forth at reel 012052, frame 0484.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, Appellants' legal representative, or assignee, which directly affect or would be directly affected by or have a bearing on the Board's decision in the present appeal.

STATUS OF CLAIMS

Claims 7-26 were finally rejected by the Examiner as noted in the Final Office Action dated June 29, 2005. The rejection of claims 12, 13, 20, and 26, as amended is being appealed.

STATUS OF AMENDMENTS

An amendment under 37 C.F.R. § 1.116 was submitted on August 30, 2005 (hereinafter, "Amendment B") for consideration. In an Advisory Action dated September 12, 2005, entry of the described Amendment B was denied, indicating that further search and consideration by the Examiner was required while acknowledging that the amendments requested in Amendment B merely canceled previously-pending claims and effectively incorporated dependent claims elements and/or limitations into existing independent claims without impacting the scope of other dependent claims. In an Examiner interview teleconference on September 28, 2005, Appellants' representative contacted the Examiner's supervisor, Heather Herndon, requesting entry of Amendment B and was informed that Amendment B would be entered prior to Appeal as it merely cancels claims and presents rejected claims in better form for consideration on appeal and that a good and sufficient reasons for its entry were provided.

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SUMMARY OF THE CLAIMED SUBJECT MATTER

In the claimed embodiment of Appellants' claim 12, a method of displaying status information for a machine via a web interface between said machine and a web server is recited which comprises

- maintaining status data for said machine utilizing said machine; (see, e.g., Appellants' specification, page 8, lines 12-27)
- receiving a request from a user to view a web page comprising said status information; (see, e.g., block 403 of Appellants' Fig. 4; and Appellants' specification, page 7, lines 11-12)
- causing said web page to be displayed to said user utilizing said web server in response to said receiving in order to reduce an amount of processing work required by said machine, wherein

- said causing comprises

- generating a new markup language file in response to a determination that said status data has been previously updated, and
- transmitting said new markup language file to said user in response to said generating,

(see, e.g., blocks 407, 409, and/or 411 of Appellants' Fig. 4; and Appellants' specification, page 8, line 29 – page 9, line 26)

- said request comprises data specifying a requested human language, (see, e.g., Appellants' specification, page 7 lines 21-25) and
- said generating comprises generating said new markup language file in only said requested human language (see, e.g., Appellants' specification, page 7 lines 21-25).

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In the claimed embodiment of Appellants' claim 20, a data processing system for displaying machine status information is recited which comprises

- a machine configured to maintain status data specifying a status of said machine (e.g., a tape library, see Appellants' specification, page 8, lines 3-14 and web server/library 112 of Appellants' Fig. 3);
- a web server (web server 270 of Appellants' Fig. 2) coupled to said machine via a web interface, wherein said web server comprises

- means for receiving a request from a user to view a web page comprising said machine status information (web server 270 of Appellants' Fig. 2; block 403 of Appellants' Fig. 4; and Appellants' specification, page 7, lines 11-12),
- means for causing said web page to be displayed to said user in response to said request in order to reduce an amount of processing work required by said machine, wherein

- said means for said causing comprises

- means for generating a new markup language file in response to a determination that said status data has been previously updated, and
- means for transmitting said new markup language file to said user

(web server 270 of Appellants' Fig. 2; blocks 407, 409, and/or 411 of Appellants' Fig. 4; and Appellants' specification, page 8, line 29 – page 9, line 26)

- said request comprises data specifying a requested human language, (see, e.g., Appellants' specification, page 7 lines 21-25) and
- said means for generating comprises means for generating said new markup language file in only said requested human language (web server 270 of Appellants' Fig. 2; and Appellants' specification, page 7 lines 21-25).

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In the claimed embodiment of Appellants' claim 26, a computer-readable medium encoded with a computer program (Appellants' specification, page 10, lines 9-16), which when executed by a processor, causes said processor to implement a method of displaying status information for a machine via a web interface between said machine and a web server is recited wherein the method comprises

- maintaining status data for said machine utilizing said machine (see, e.g., Appellants' specification, page 8, lines 12-27);
- receiving a request from a user to view a web page comprising said status information; (see, e.g., block 403 of Appellants' Fig. 4; and Appellants' specification, page 7, lines 11-12) and
- causing said web page to be displayed to said user utilizing said web server in response to said receiving in order to reduce an amount of processing work required by said machine, wherein
 - said causing comprises
 - generating a new markup language file in response to a determination that said status data has been previously updated, and
 - transmitting said new markup language file to said user in response to said generating(see, e.g., blocks 407, 409, and/or 411 of Appellants' Fig. 4; and Appellants' specification, page 8, line 29 – page 9, line 26)
 - said request comprises data specifying a requested human language, (see, e.g., Appellants' specification, page 7 lines 21-25) and
 - said generating comprises generating said new markup language file in only said requested human language (see, e.g., Appellants' specification, page 7 lines 21-25).

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GROUND'S OF REJECTION TO BE REVIEWED ON APPEAL

The Examiner's rejections of claims 12, 13, 20, and 26 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application No. 2002/0075297 (naming Brendan Boulter as inventor, hereinafter "*Boulter*") in view of *Windows 98 Unleashed, Chapter 33: Exploring the Web with Internet Explorer*, Paul McFedries, Sam's Publishing (May 1998) (herein after "*McFedries*") is to be reviewed on Appeal.

ARGUMENT

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference(s) or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Moreover, when applying 35 U.S.C. 103, both the claimed invention and the cited references must be considered as a whole and the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 229 USPQ 182, (Fed. Cir. 1986). Appellants respectfully submit that the Examiner's cited reference fails to teach, show, or suggest all elements of Appellants' claims.

Neither reference teaches the generation of a web page in only a requested human language

Exemplary claim 12 of the above-identified patent application recites a method of displaying status information for a machine via a web interface between said machine and a web server comprising *inter alia*,

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*receiving a request from a user to view a web page comprising said status information;
and
causing said web page to be displayed to said user utilizing said web server in response
to said receiving in order to reduce an amount of processing work required by
said machine, wherein
said causing comprises
generating a new markup language file in response to a determination
that said status data has been previously updated, and
transmitting said new markup language file to said user in response to
said generating,
said request comprises data specifying a requested human language, and
said generating comprises generating said new markup language file in only said
requested human language.*

In the Final Office Action dated June 29, 2005 the Examiner acknowledges that *Boulter* fails to teach, show, or suggest the generation of a markup language file in only a requested human language, stating rather that “[*McFedries*] teaches a language preference dialog box which enables you to add one or more languages to Internet Explorer. This enables Internet Explorer to handle foreign language pages. You can also use this dialog box to set up relative priorities for the designated languages (see pg. 4, page 4)” and that it would have been obvious at the time of Appellants’ invention to modify the teaching of *Boulter* with the teachings of *McFedries*/Internet Explorer to include specifying a requested human language and generating a new markup language file in only the requested human language, “for the motivational purpose of designating languages in the web browser for building web pages.” Appellants respectfully disagree.

As clearly indicated by both the teaching of *McFedries* and the Examiner’s Final Office Action dated June 29, 2005, *McFedries* teaches “Exploring the Web with Internet Explorer” a web browser client application which is utilized to receive and display web page data to a user. A web browser is defined by the Microsoft Computer Dictionary, Fourth Edition as, “Software that lets a user view HTML documents and access files and software related to those documents.” (emphasis supplied) Appellants note that the Examiner has provided no further evidence that *McFedries* or the knowledge of one or ordinary skill in the relevant art at the time of Appellants’ invention would teach or suggest the use of Internet Explorer for the generation of an HTML or other markup language document. Moreover, while the Examiner’s cited portion of

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McFedries describes that Internet Explorer may be configured using a Languages Preferences dialog box to “handle” foreign language pages and to set up relative priorities for designated languages, it does not restrict the generation of such pages and may be construed as implicitly indicating the generation of pages in languages other than those explicitly requested contrary to Appellants’ claimed invention embodiments. Consequently, as Appellants’ claims recite the generation of a markup language file rather than merely the “viewing” of such a file, Appellants respectfully submit that *McFedries* fails to teach, show or suggest, “*generating a new markup language file in response to a determination that said status data has been previously updated*” and consequently, “*generating said new markup language file in only said requested human language*” as claimed.

Boulter, by contrast teaches the use of a monitoring system (web server) 118 in generating and updating screens representing device-status information in the form of an HTML file. *Boulter* fails however, as acknowledged by the Examiner, to teach, show or suggest the generation of a markup language file in only a requested human language. Appellants therefore respectfully submit that the combined teachings of *Boulter* and *McFedries* fail to teach, show, or suggest, “*generating a new markup language file*” as claimed.


For at least the foregoing reasons, Applicants respectfully submit that claim 12, as amended, is allowable in view of the Examiner’s cited references *Boulter* and *McFedries*. Applicants’ claims 13, 20, and 26 each include one or more elements substantially similar to those described with respect to claim 12 either independently or by virtue of their dependency and are therefore allowable for at least the reasons stated with respect to that claim.

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CONCLUSION

Appellants have pointed out with specificity the manifest errors in the Examiner's rejections, and the claim language that renders the invention patentable over the reference. Appellants, therefore, respectfully request that this case be remanded to the Examiner with instructions to issue a Notice of Allowance for all pending claims.

Respectfully submitted,



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CLAIMS APPENDIX

1-11. (canceled)

12. A method of displaying status information for a machine via a web interface between said machine and a web server, said method comprising:

maintaining status data for said machine utilizing said machine;

receiving a request from a user to view a web page comprising said status information;

and

causing said web page to be displayed to said user utilizing said web server in response to said receiving in order to reduce an amount of processing work required by said machine, wherein

said causing comprises

generating a new markup language file in response to a determination that

said status data has been previously updated, and

transmitting said new markup language file to said user in response to said

generating,

said request comprises data specifying a requested human language, and

said generating comprises generating said new markup language file in only said requested human language.

13. The method of claim 12, wherein

said data specifying said requested human language comprises data specifying a plurality of requested human languages, and

said generating comprises generating said new markup language file in only each of said plurality of requested human languages.

14-19. (canceled)

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20. A data processing system for displaying machine status information comprising:
a machine configured to maintain status data specifying a status of said machine;
a web server coupled to said machine via a web interface, wherein said web server comprises
means for receiving a request from a user to view a web page comprising said machine status information,
means for causing said web page to be displayed to said user in response to said request in order to reduce an amount of processing work required by said machine, wherein
said means for said causing comprises
means for generating a new markup language file in response to a determination that said status data has been previously updated, and
means for transmitting said new markup language file to said user
said request comprises data specifying a requested human language, and
said means for generating comprises means for generating said new markup language file in only said requested human language.

21-25 (canceled)

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26. A computer-readable medium encoded with a computer program, which when executed by a processor, causes said processor to implement a method of displaying status information for a machine via a web interface between said machine and a web server, said method comprising:

- maintaining status data for said machine utilizing said machine;
- receiving a request from a user to view a web page comprising said status information;
- and
- causing said web page to be displayed to said user utilizing said web server in response to said receiving in order to reduce an amount of processing work required by said machine, wherein

said causing comprises

- generating a new markup language file in response to a determination that
- said status data has been previously updated, and
- transmitting said new markup language file to said user in response to said

generating

said request comprises data specifying a requested human language, and

said generating comprises generating said new markup language file in only said requested human language.

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EVIDENCE APPENDIX

Other than the Office Action(s) and reply(ies) already of record, no additional evidence has been entered by Appellants or the Examiner in the above-identified application which is relevant to this appeal.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings as described by 37 C.F.R. §41.37(c)(1)(x) known to Appellants, Appellants' legal representative, or assignee.